

### **Remarks/Arguments**

Reconsideration of this application in light of the above amendments and the following remarks is requested.

Original claims 1 and 2 have been amended, and no claims have been added or deleted. Thus, claims 1-11 remain pending in the present application.

#### Rejections Under 35 U.S.C. § 112

Claims 1 and 2 were rejected under 35 U.S.C. § 112, second paragraph. Claims 1 and 2 are presently amended to correct inadvertent errors of a minor nature and otherwise comply with the requirements of § 112. Consequently, Applicant requests that the rejection be withdrawn.

#### Rejections Under 35 U.S.C. § 103

##### Claim 1

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0160688 to Rehkemper ("Rehkemper") in view of U.S. Patent No. 2,587,142 to Gray ("Gray") and U.S. Patent No 6,632,121 to Edmisson ("Edmisson"). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 1.

Claim 1 recites:

A radio-controlled toy car and controller kit, the kit comprising:  
an unassembled toy car, the unassembled toy car comprising a chassis having a pair of wheels, a motor adapted to be removably inserted into the chassis, a pair of hubcaps adapted to be removably secured to the wheels, and a pair of tires adapted to be removably secured to the wheels; and  
a controller for transmitting radio signals to the toy car.

As the PTO recognizes in MPEP § 2142:

*...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner cannot factually support a *prima facie* case of obviousness for the following mutually exclusive reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Rehkemper, Gray, and Edmisson references cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the combination of Rehkemper, Gray, and Edmisson does not teach “a pair of hubcaps adapted to be removably secured to the wheels.” That is, the Examiner concedes that Rehkemper and Edmisson fail to disclose “a pair of hubcaps adapted to be removably secured to the wheels.” Moreover, Gray teaches “... threaded front hubcaps 24 which screw on the extremities of the threaded spindles 22” (column 2, lines 26-32), in contrast to the hubcaps 24 being adapted to be removably secured to the front wheels 21.

Thus, for this mutually exclusive reason, the Examiner’s burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and any rejection under 35 U.S.C. § 103 is not applicable to claim 1.

## **2. The Combination of References is Improper**

There is still another, mutually exclusive and compelling reason why the Rehkemper, Gray, and Edmisson references cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical >person of ordinary skill in the art= when the invention was unknown and just before it was made.....Knowledge of the applicant's disclosure must be put aside ... impermissible hindsight must be avoided.*

Here, neither Rehkemper, Gray, nor Edmisson teaches, or even suggests, the desirability of the combination of claim 1 since neither teaches “a pair of hubcaps adapted to be removably secured to the wheels,” as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection of claim 1.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the combination of the Rehkemper, Gray, and Edmisson references arises solely from hindsight based on the invention without any showing, suggestion, incentive, or motivation in any of the references for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. § 103 is not applicable to claim 1.

**3. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the Gray reference, by providing sufficient play for the front wheels 21 between the corresponding shoulders 23 and hubcaps 24 to permit the front wheels 21 to rotate freely on their respective spindles 22 (column 2, lines 36-40), is directed to a toy car having front wheels that rotate relative to corresponding hubcaps. Modifying the hubcaps in Gray such that the hubcaps 24 are also removably secured to the wheels 21 would prevent rotation of the wheels 21. Thus, Gray clearly teaches away from claim 1.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met, and the rejection under 35 U.S.C. § 103 should be withdrawn.

Claim 10

Claim 10 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rehkemper in view of Gray and Edmisson. Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 10.

Claim 10 recites:

A toy car kit having a plurality of unassembled toy car components, the unassembled components, comprising:  
a chassis having a pair of front wheels;  
a pair of hubcaps attachable to the front wheels;  
a pair of tires attachable to the front wheels;  
a motor adapted for insertion into a compartment of the chassis, the motor having a drive gear associated therewith;  
a motor retaining clip attachable to the chassis to secure the motor to the chassis;

- a transfer gear attachable to the chassis and engaging the drive gear;
- an axle attachable to the chassis, the axle having an axle gear for engaging with the transfer gear and a pair of rear wheels fixedly disposed on the axle;
- a pair of hubcaps attachable to the rear wheels;
- a pair of tires attachable to the rear wheels; and
- a body attachable to the chassis;

wherein the unassembled components are packaged in the kit.

Thus, claim 10 includes recitation similar to the recitation of “a pair of hubcaps adapted to be removably secured to the wheels” as recited in claim 1. Consequently, each of the above-described mutually exclusive reasons for why the Examiner cannot factually support a *prima facie* case of obviousness of claim 1 are also applicable to claim 10.

#### Claim 11

Claim 11 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Rehkemper in view of Gray and Edmisson. Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claim 11.

Claim 11 recites:

- A toy car kit comprising:
  - a housing;
  - a plurality of unassembled toy car components disposed in the housing, the unassembled components comprising:
    - a chassis having a pair of front wheels;
    - a pair of hubcaps attachable to the front wheels;
    - a pair of tires attachable to the front wheels;
    - a motor adapted for insertion into a compartment of the chassis, the motor having a drive gear associated therewith;
    - a motor retaining clip attachable to the chassis to secure the motor to the chassis;

- a transfer gear attachable to the chassis and engaging the drive gear;
- an axle attachable to the chassis, the axle having an axle gear for engaging with the transfer gear and a pair of rear wheels fixedly disposed on the axle;
- a pair of hubcaps attachable to the rear wheels;
- a pair of tires attachable to the rear wheels; and
- a body attachable to the chassis.

Thus, claim 11 includes recitation similar to the recitation of “a pair of hubcaps adapted to be removably secured to the wheels” as recited in claim 1. Consequently, each of the above-described mutually exclusive reasons for why the Examiner cannot factually support a *prima facie* case of obviousness of claim 1 are also applicable to claim 11.

**Conclusion**

It is clear from all of the foregoing that independent claims 1, 10, and 11 are in condition for allowance. Dependent claims 2-9 depend from and further limit independent claim 1 and, therefore, are allowable as well.

An early formal notice of allowance of claims 1-11 is requested.

Respectfully submitted,



Dave R. Hofman  
Registration No. 55,272

Dated: 7/9/04

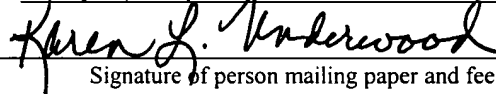
HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 972/739-8630  
File: 2030.78

R-79349.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on

7-9-04



Signature of person mailing paper and fee